

REMARKS

Applicant understands and appreciates the Examiner entering the Amendment of the June 14, 2005 Amendment and Response.

Applicant respectfully requests reconsideration of the instant application in the view of the foregoing amendments and the following remarks. Claims 1-7, 9-18 and 20-23 are currently pending in the instant application. Although claims 22 and 23 have been amended, Applicant reserves the right to pursue the un-amended version of the claims at a future date as "signal" language is patentable subject matter. Applicant submits that support for the Amendment may be found throughout the specification and originally-filed claims, and that no new matter has been added.

Rejection Under 35 USC § 101

Claims 22 and 23 have been rejected under 35 U.S.C. § 101 as being unpatentable over the Examiner's assertion that "the claimed invention is directed to non-statutory subject matter" (12/01/06 Office Action, page 2). Applicant respectfully disagrees. Applicant submits that "such signal claims" (12/01/06 Office Action, page 2), as cited by the Examiner, are not precluded, and Applicant reserves the right to pursue this matter at a future time. However, in order to expedite prosecution and allowance of independent claim 22, and claim 23 depending therefrom, the claims have been amended to recite, *inter alia*, "A computer instruction...". As such, Applicant respectfully requests withdrawal of the §101 rejection.

Rejection Under 35 USC § 112

Claims 10 and 11 have been rejected under 35 U.S.C. § 112 over the Examiner's assertion that the claims are "indefinite for failing to particularly point out and distinctly claim

the subject matter which the applicant regards as the invention" (12/01/06 Office Action, page 3). Applicant respectfully traverses the rejection.

Regarding the rejection of claims 10 and 11, the Examiner asserts "the relationship of the converting a physical security into an electronic format to generating documentation supportive of the trade is not clearly recited which renders claims 10 and 11 unclear" (12/01/06 Office Action, page 3). Applicant respectfully disagrees.

Applicant submits that the claims are clear and definite. Specifically, Applicant submits that the claims cited by the Examiner clearly set forth the relationship "of the converting a physical security into an electronic format to generating documentation supportive of the trade". Applicant respectfully directs the Examiner to paragraph [0014] of the Application which provides a non-limiting example of such, reciting, *inter alia*:

Documentation that is generated can include a seller's letter, a broker's letter and/or a legal opinion... In addition, an instruction can be transmitted to a transfer agent to convert physical restricted securities into an electronic format. Notification that the securities have been converted can subsequently be received.

Accordingly, Applicant requests withdrawal of the rejection and allowance of the claims.

Rejection Under 35 USC § 103

Claims 1-7 and 9 have been rejected under 35 U.S.C. § 103 as being unpatentable over the Examiner's assertion of Michaels, Jenna; Compliance Under Control; Wall Street and Technology; May 1997, Vol. 9, Issue 9; Pg. 17 (hereafter Wall Street) in further view of Millard et al. (US PGPub 2002/0007335). Applicant respectfully traverses the rejection.

With regard to the Examiner's rejection of claim 1 and claims depending therefrom, the Examiner asserts obviousness over Wall Street in further view of Millard. Applicant respectfully disagrees. The Examiner asserts Wall Street teaches "automatically generating

documentation supportive of the trade wherein the generated documents include at least a legal opinion (pg.2 para 5 Automated Compliance System's audit trail include includes a restriction)" (12/01/06 Office Action, page 4). Applicant respectfully disagrees. In the section referenced by the Examiner, Wall Street discusses that "the trader needs the appropriate password to override a restriction, and he also has to give a reason the trade should be allowed" (Wall Street, pg. 2, paragraph 5) and in no way addresses "generating documentation supportive of the trade where the generated documents include at least a legal opinion indicating whether or not the trade restrictions have been satisfied" as required by claim 1. The trader is not a legal expert and in no way is including a legal opinion as a "reason". Therefore, the citation does not satisfy the claimed elements.

Regarding Millard et al., as previously noted by the Examiner "Millard fails to teach that the generated documents include at least a legal opinion" (6/02/06 Office Action, page 3) as required by claim 1, and, as such, does not satisfy the claimed elements. Thus, it is respectfully submitted that since neither Wall Street nor Millard et al. individually address "generating documentation supportive of the trade where the generated documents include at least a legal opinion indicating whether or not the trade restrictions have been satisfied", the combination of said references similarly does not anticipate claim 1 for at least the same reason.

Claims 2-7 and 9 depend from independent claim 1. As such, they contain the same "generating documentation supportive of the trade where the generated documents include at least a legal opinion indicating whether or not the trade restrictions have been satisfied" limitation shown to be absent from both Wall Street and Millard et al., as discussed above. Accordingly, it is respectfully submitted that claims 2-7 and 9 are not obvious over the combination of Wall Street and Millard et al. for at least the same reasons discussed above.

The Examiner has rejected claims 10 and 11 under 35 U.S.C. § 103 as being obvious over Wall Street and further in view of Study outlines need to automate market, USA Today, Dec 15, 1991 (hereafter USA Today). Claims 10 and 11 depend from independent claim 1. As such, they contain the same "generating documentation supportive of the trade where the generated documents include at least a legal opinion indicating whether or not the trade restrictions have been satisfied" limitation shown to be absent from Wall Street, as discussed above. Similarly, USA Today also does not disclose "generating documentation supportive of the trade where the generated documents include at least a legal opinion indicating whether or not the trade restrictions have been satisfied". Accordingly, it is respectfully submitted that claims 10 and 11 are not obvious over the combination of Wall Street and USA Today for at least the same reasons discussed above.

Claims 12-15 have been rejected under 35 U.S.C. § 103 as being unpatentable over the Examiner's assertion of Wall Street in further view of Millard et al. Applicant respectfully traverses the rejection.

With regard to the Examiner's rejection of claim 12 and claims 13-15 depending therefrom, the Examiner asserts obviousness over Wall Street in further view of Millard, stating "all other limitations of claim 12 have been analyzed in accordance with the corresponding process claim 1" (12/01/06 Office Action, page 5). Following the Examiner's reasoning, Applicant respectfully submits that, since the combination of Wall Street and Millard et al. fails to "generating documentation supportive of the trade where the generated documents include at least a legal opinion indicating whether or not the trade restrictions have been satisfied" limitation of claim 1 (discussed above), this same combination of references similarly fails to

address the "receive a legal opinion document related to the trade" limitation of independent claim 12 and claims 13-15 depending therefrom.

Regarding claims 16-18 and 19-23, the Examiner has only provided references to previous rejections, "Claim 16 is similarly as claims 12... Claims 22 and 23 and analyzed according to product claims 12-15" (12/01/06 Office Action, page 5-6). Applicant respectfully traverses the rejection. As the Examiner has cited only cited previous claims, Applicant directs the Examiner to the above-provided responses corresponding to cited claims. Accordingly, it is respectfully submitted that claims 16-18 and 19-23 overcome the rejection for at least the same reasons discussed above.

In order to facilitate clear communication, the Applicant would like to remind the Examiner that, with regard to Millard et al., there appears to be a discrepancy between the paragraph numbering of the HTML version ([http://appft1.uspto.gov/...](http://appft1.uspto.gov/)) and the published/PDF version ([http://aiwl.uspto.gov/...](http://aiwl.uspto.gov/)). For example, in the HTML version, [0218] begins "Records of previous postings", while in the published/PDF version, [0218] begins "After the details of the offer". For ease of communication, the Applicant again requests that the Examiner specify the appropriate version of Millard et al. when cited in future correspondence.

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-7, 9-18 and 20-23, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes

that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-005.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to

grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-005

Respectfully submitted,
CHADBOURNE & PARKE, L.L.P.

Dated: March 1, 2007

By: /Walter G. Hanchuk/
Walter G. Hanchuk Reg. No. 35,179

Chadbourne & Parke LLP
30 Rockefeller Plaza
New York, NY 10112
212-408-5100 Telephone
212-541-5369 Facsimile